

REMARKS

Claims 1-5, 10, and 11 are pending. The Examiner stated that claims 1-3, 10, and 11 are allowable. Claims 4 and 5 stand rejected.

Claim 4 is amended herein to recite that the primer or probe includes the nucleotide at position 6055 of SEQ ID NO:2. Support for this amendment can be found in claim 1, for example. Claim 5 is amended to recite that the method comprises determining whether or not a sample of material taken from the subject comprises a polynucleotide that corresponds to SEQ ID NO:2 and has an A at position 6055, or the complement thereof, wherein the determining comprises using the DNA primer or probe of claim 10, and diagnosing the subject as having parkinsonism inheritance if the sample comprises the polynucleotide. Support for this amendment can be found throughout Applicants' specification. *See*, for example, page 1, lines 3-5, and page 2, lines 5-6 and 21-22. Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 4 and 5, in addition to previously allowed claims 1-3, 10, and 11.

Rejection under 35 U.S.C. § 101

The Examiner rejected claim 5 under 35 U.S.C. § 101, alleging that the claimed recitation of a use, without setting forth any steps involved in the process, results in a claim that is not a proper process claim under 35 U.S.C. § 101.

Applicants respectfully disagree. Previous claim 5 recited the active step of using a DNA primer or probe to determine whether or not a sample of material taken from a subject comprises a particular polynucleotide. Nevertheless, to further prosecution, Applicants have amended claim 5 to recite determining whether or not a sample of material taken from a subject comprises the recited polynucleotide, and also to recite diagnosing the subject as having parkinsonism inheritance if the material comprises the polynucleotide. Present claim 5 thus recites steps involved in the claimed method.

In light of the above, Applicants respectfully request withdrawal of the rejection of claim 5 under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 112

The Examiner rejected claim 5 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner asserted that claim 5 provides for the use of a DNA primer or probe, but that it does not set forth any steps involved in the method/process, and thus it is unclear what the claim is intended to encompass.

Applicants respectfully disagree. Again, previous claim 5 recited the active step of using a DNA primer or probe to determine whether or not a sample of material taken from a subject comprises a particular polynucleotide. Without acquiescing to the Examiner's rejection, however, Applicants have amended claim 5 to recite determining whether or not a sample of material taken from a subject comprises the recited polynucleotide, and diagnosing the subject as having parkinsonism inheritance if the material comprises the polynucleotide. Present claim 5 is clear and definite.

In light of the above, Applicants' respectfully request withdrawal of the rejection of claim 5 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 102

The Examiner rejected claim 4 under 35 U.S.C. § 102(b) as allegedly being anticipated by PCT Publication No. WO 02/081629 (the Spytek et al. publication). Specifically, the Examiner asserted that RTQ-PCR probe #3 of human protein NOV19 (of the Spytek et al. publication) is identical to nucleotides 6984 to 7010 of present SEQ ID NO:2.

Applicants respectfully disagree. Claim 4 recites a DNA primer or probe specific for the polynucleotide of claim 1. Claim 1 recites a polynucleotide consisting of the base sequence of SEQ ID NO:2, or a complementary strand thereto, wherein the nucleotide at position 6055 of SEQ ID NO:2 is A, C or T. In order for a DNA primer or probe to be specific to the polynucleotide of claim 1, it must be specific for a polynucleotide having an A, C, or T at the nucleotide corresponding to position 6055 of SEQ ID NO:2. Given that the sequence cited by

the Examiner is nowhere near position 6055 of SEQ ID NO:2, it would not necessarily be specific for the polynucleotide recited in claim 1.

To further prosecution, however, Applicants have amended claim 4 to recite that the primer or probe includes the nucleotide at position 6055 of SEQ ID NO:2. Present claim 4 clearly is not anticipated by the Spytek et al. publication. Thus, Applicants respectfully request withdrawal of the rejection of claim 4 under 35 U.S.C. § 102(b).

Allowed claims

Applicants acknowledge the allowability of claims 1-3, 10, and 11.

CONCLUSION

Applicants respectfully request allowance of claims 4 and 5, in addition to previously allowed claims 1-3, 10, and 11. The Examiner is invited to telephone the undersigned agent if such would further prosecution.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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